

Remarks

Status of the Claims

By the foregoing amendments, claims 1-38 have been cancelled without prejudice or disclaimer, and new claims 39-56 are sought to be entered. Support for the foregoing amendments to the claims can be found throughout the specification and the Examples. Specifically, support for new claims 39-56 can be found at pages 31-33; at pages 40-41; at pages 57-59; at pages 68-76; at pages 78-79; and throughout the Examples, specifically Example 21, at pages 156-159. Accordingly, these amendments to the claims do not add new matter, and their entry and consideration are respectfully requested. Upon entry of the foregoing amendments, claims 39-56 are pending in the application, with claims 39, 50 and 52 being the independent claims.

Applicants note that during telephone conferences held with Applicants' undersigned representative on April 8, 2004, and July 13, 2004, the Examiner authorized Applicants to file a new claim set and to cancel claims 1-38, even if the new claim set might be directed to subject matter that was not elected in the Reply to Restriction Requirement and Requirement for Election of Species filed on June 27, 2002. Applicants thank the Examiner in advance for agreeing to enter and consider the foregoing new claims.

The Rejections Under 35 U.S.C. § 112, First Paragraph

In the Office Action at page 3, the Examiner has maintained the rejection of claims 33-34 and 38 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 33-34 and 38 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at pages 4-5, the Examiner has maintained the rejection of claims 1, 2, 10-11, 15-16, 18-21, and 36-38, under 35 U.S.C. § 112, second paragraph, alleging that the phrase "an ___ nucleotide sequence as set forth in Figure 9," does not clearly limit the claims to a particular sequence. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 1, 2, 10-11, 15-16, 18-21, and 36-38 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at pages 5-6, the Examiner has maintained the rejection of claims 1, 10-11, 15-16, 18-21 and 36-38, under 35 U.S.C. § 112, second paragraph, alleging that it is unclear whether the phrases "polynucleotide complementary thereto" and "a mutant, fragment or derivative thereof" refer to each of the previously recited sequences, or to only the sequence immediately prior to the recitation. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 1, 10-11, 15-16, 18-21 and 36-38 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at pages 6-7, the Examiner has maintained the rejection of claim 11, under 35 U.S.C. § 112, second paragraph, alleging that it is unclear how or

whether the claim is intended to further limit the sequences of claim 10, or the transcriptional regulatory sequences. The Examiner further alleges that there is insufficient antecedent basis for the limitation "said transcriptional regulatory sequence." Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claim 11 has been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at page 7, the Examiner has maintained the rejection of claims 15-16, 18 and 37, under 35 U.S.C. § 112, second paragraph, alleging that it is unclear whether the recitation "linked to a target-specific nucleotide sequence useful in amplifying said target nucleotide sequence" in claim 15 refers back to and limits the "primer nucleic acid molecule" or the "target nucleotide sequence." The Examiner further alleges that it is unclear whether the phrase "linked to a target-specific nucleotide sequence useful in amplifying said target nucleotide sequence" limits only the "portion thereof" or applies to any primer encompassed by the claim. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 15-16, 18 and 37 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at pages 7-8, the Examiner has maintained the rejection of claim 16, under 35 U.S.C. § 112, second paragraph, alleging that it is indefinite. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claim 16 has been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at page 8, the Examiner has maintained the rejection of claims 26-28 and 36, under 35 U.S.C. § 112, second paragraph, alleging that these claims are indefinite. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 26-28 and 36 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at page 9, the Examiner has maintained the rejection of claims 27 and 28, under 35 U.S.C. § 112, second paragraph, alleging that these claims are indefinite. Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 27 and 28 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

In the Office Action at pages 9-10, the Examiner has maintained the rejection of claims 29 and 32, under 35 U.S.C. § 112, second paragraph, alleging that it is unclear whether "its core region" refers to the isolated nucleic acid molecule or to the one or more *att* recombination sites. The Examiner further alleges that there is insufficient antecedent basis for the term "said mutated *att* recombination site." Applicants respectfully traverse this rejection. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 29 and 32 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

The Rejection Under 35 U.S.C. § 102(b) Over Hartley

In the Office Action at pages 10-11, the Examiner has maintained the rejection of claims 1-2, 10-11, 15-16, 18-21, 26-29 and 36-38, under 35 U.S.C. § 102(b) as being allegedly anticipated by Hartley *et al.* (WO 96/40724; hereinafter "Hartley"). Applicants respectfully traverse this rejection.

Applicants respectfully disagree with the Examiner's contentions and conclusions. However, solely to expedite prosecution, and not in acquiescence to this rejection, claims 1-2, 10-11, 15-16, 18-21, 26-29 and 36-38 have been cancelled without prejudice or disclaimer. Thus, this rejection has been rendered moot.

Conclusion

All of the stated grounds of rejection have been properly traversed, rendered moot, or otherwise overcome. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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